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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,322	04/13/2004	Thomas G. Woolston	2043.566US7	5381

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SCHWEGMAN, LUNDBERG & WOESSNER/EBAY  
P.O. BOX 2938  
MINNEAPOLIS, MN 55402

EXAMINER
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ALLEN, WILLIAM J

ART UNIT	PAPER NUMBER
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3625

NOTIFICATION DATE	DELIVERY MODE
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08/05/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@SLWIP.COM

<b>Office Action Summary</b>	<b>Application No.</b> 10/824,322	<b>Applicant(s)</b> WOOLSTON, THOMAS G.	
	<b>Examiner</b> WILLIAM J. ALLEN	<b>Art Unit</b> 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 6-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2 and 6-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Prosecution History Summary***

Claims 3-5 are cancelled.

Claims 1-2 and 6-10 are pending and rejected as set forth below.

### ***Response to Arguments***

Applicant's arguments filed 5/14/2009 have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

On pages 4-5, Applicant contests that PTO 892 V fails to teach *changing said data record to reflect a new offer price from said second owner and posting said good on said market maker computer at said second owner offer price* and states "the Cox reference does not relate to or describe a computerized market, and specifically does not describe the above limitations". The Examiner reiterates that Nahan clearly teaches a computerized environment and further provides updating an item record/item history including previous prices paid for the item and an (see at least: col. 4 lines 54-58, col. 13 lines 3-12), and further notes that, as set forth in the previous action, the combination indeed teaches the claimed limitations.

The Examiner draws attention to Page 5 of the previous action. As established on page 5, financial speculation involves exchanging ownership of an item from a first owner to a second

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owner and the second owner providing the purchased item for sale at an increased price. This aspect of changing price is analogous to Applicant's claimed feature of *changing the data record to reflect a new offer price and posting said good at the second offer price*. In this context, PTO 892 V provides adequate teachings that are equivalent to the missing claim features not taught by Nahan. For example, in the field of art speculation, PTO 892 V teaches where it is known for buyers to play the market by "buying art, waiting for a run-up in prices and selling" (see Box 1, also note Boxes 2-3). PTO 892 V further teaches where one investor "plans to raise prices on current Johns works by about 20% because of strong demand" (see Box 5). Lastly, PTO 892 V also teaches where "important paintings are being bought by investors" where "sometimes they don't even bother to pick them up" (i.e. no change to the item record outside of price) (see Box 4).

When taken in combination with the computerized environment of Nahan, Nahan and PTO 892 V teach Applicant's invention as claimed. More specifically, there was no technological advance beyond the skill shown in Nahan as the combination is merely the adaptation of an old idea or invention (i.e. speculation in the field of artwork, collectibles, or the like – taught by PTO 892 V) using newer technology (i.e. Nahan) that is commonly available and understood in the art. The combination, then, would be obvious in order to gain the commonly understood benefits of such adaptation, such as facilitating the purchase and resale of artwork, collectibles, or the like for profit (see at least: PTO 892 V, Boxes 1 and 5). This would be accomplished with no unpredictable results. As stated in *Leapfrog*, "applying modern electronics to older mechanical devices has been commonplace for years." (*Leapfrog Enterprises, Inc. v. Fisher-Price*, 485 F.3d 1157, 82USPQ2d 1687 (Fed. Cir 2007)).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**1. Claims 1, 6, and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nahan et al. (US 5664111) in view of PTO form 892 reference V.**

**Regarding claim 1**, Nahan teaches a method for creating a computerized market for used goods and collectibles using a computer, a database and a plurality of participant terminals comprising the steps of:

*posting a used or collectable good on a market maker computer by creating a data record for said good having an item identification and offer price (see at least: abstract lines 4-9, col. 2 lines 57-59, col. 2 line 60-col. 3 line 9);*

*displaying in response to a participant request from said participant terminal to display said data record information on said participant terminal (see at least: abstract lines 14-18, col. 3 lines 6-9, col. 7 lines 60-62, col. 7 lines 65-col. 8 line 3, col. 8 Table 1 and lines 26-30, col. 9 lines 61-62, col. 10 lines 9-12 and 56-62, Fig. 6));*

*processing an order to buy said good from said participant terminal by transferring ownership of said good from a first owner to a second owner (see at least: abstract lines 24-30, col. 2 lines 42-45, col. 4 lines 1-6 and 32-35).*

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Despite teaching the above, Nahan does not expressly teach *changing said data record to reflect a new offer price from said second owner and posting said good on said market maker computer at said second owner offer price*. Along these lines, however, Nahan does indeed teach an item history, the item history including previous prices paid for the item and an updated item record (see at least: col. 4 lines 54-58, col. 13 lines 3-12).

The above noted features are analogous to financial speculation in the arena of artwork, collectibles, and antiquities. Financial speculation involves the buying, holding, selling, and short-selling of stocks, bonds, commodities, currencies, collectibles, real estate, derivatives, or any valuable financial instrument to profit from fluctuations in its price as opposed to buying it for use or for income via methods such as dividends or interest. In other words, speculation involves exchanging ownership of an item from a first owner to a second owner and the second owner providing the purchased item for sale at an increased price (i.e. analogous to *changing the data record to reflect a new offer price and posting said good at the second offer price*). The noted features, then, would have been obvious because the incorporation of such features is recognized as part of the ordinary capabilities of one of ordinary skill in the art.

In this field of endeavor, PTO form 892 reference V teaches the advent of speculation in art auctions (see at least: Boxes 1 & 2). More specifically, PTO 892 V teaches where it is known in the art industry for speculators to buy large holdings of art for a quick profit, often times raising the prices and reselling the works because of strong demand (see at least: Boxes 3-5).

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One of ordinary skill in the art at would have found it obvious to update Nahan using the well known aspect of speculation as found in PTO 892 V in order to gain the commonly understood benefits of such adaptation, such as facilitating the purchase and resale of artwork, collectibles, or the like for profit (see at least: PTO 892 V, Boxes 1 and 5). This would be accomplished with no unpredictable results. As stated in *Leapfrog*, "applying modern electronics to older mechanical devices has been commonplace for years." (Leapfrog Enterprises, Inc. v. Fisher-Price, 485 F.3d 1157, 82USPQ2d 1687 (Fed. Cir 2007)).

**Regarding claims 6 and 8-10**, Nahan in view of PTO 892 V further teaches:

**(6)** *electronically presenting a good from a first computerized market to a second computerized market for goods by transferring said data record created in said step of posting a good for sale from said first computerized market to said second computerized market* (see at least: col. 2 lines 57-59, col. 2 line 64-col. 3 line 6).

**(8)** *creating a data record of said step of transferring ownership of said good in said step of processing an order and storing said data record on a storage device owner* (see at least: abstract lines 24-30, col. 2 lines 42-45, col. 4 lines 1-6 and 32-35, col. 13 lines 3-12).

**(9)** *searching said data records from said step of creating a data record in response to a search request from a participant* (see at least: col. 13 lines 3-12).

**(10)** *analyzing said data records from said step of creating a data record to identify the price of a good over a predetermined period of time* (see at least: col. 13 lines 3-12).

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**2. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nahan in view of PTO 892 V as applied to claim 1 above, and further in view of Shultz et al. (US 5056019).**

**Regarding claim 2,** Nahan in view of PTO 892 V teaches all of the above noted but does not expressly teach *clearing the transfer of ownership of said used good in said step of processing by debiting an account of said second owner*. Nahan, however, does indeed teach effecting payments as part of the transfer of ownership, the payment being made via a funds transfer (see at least: col. 14 lines 6-14). Such features, however, would be recognized as readily substitutable by one of ordinary skill in the art. For example, Shultz teaches a system where customers to use their debit cards to authorize the debiting of their bank accounts for the purchase amount (see at least: col. 6 lines 43-47). It would have been obvious to one of ordinary skill in the art to include debiting a account of a second user as taught by Shultz because the claimed invention is merely a combination of old elements that would have performed the same function separately as combined and one of ordinary skill in the art would have recognized that the results of the combination were predictable.



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**3. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nahan in view of PTO 892 V as applied to claim 1 above, and further in view of Abel et al. (US 5852809).**

**Regarding claim 7,** Nahan in view of PTO 892 V teaches all of the above as noted but does not expressly teach *automatically paying a commission to said computerized market from said transfer of ownership of said good by said computerized market deducting said commission from said purchase price paid to said seller*. In the same field of endeavor, Abel teaches a system for routing data and communications to one of a plurality of remote sites to promote reciprocal interaction among the remote sites (see at least: abstract). More specifically, Abel teaches *automatically paying a commission to said computerized market from said transfer of ownership of said good by said computerized market deducting said commission from said purchase price paid to said seller* (see at least: col. 1 lines 56-59, col. 2 lines 46-53, col. 14 lines 15-17). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Nahan and PTO 892 V to have included the noted features as taught by Abel because the incorporation of such features is no more than the combination of known prior art elements according to their established function yielding predictable results.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM J. ALLEN whose telephone number is (571)272-1443. The examiner can normally be reached on 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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